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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91212680
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Trademark Application  
Serial No. 79111074 for CORN THINS and  
Serial No. 85820051 for RICE THINS

FRITO-LAY NORTH AMERICA, INC.,

Opposer,

v.

REAL FOODS PTY LTD.,

Applicant.

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Opposition No. 91212680 (Parent)  
Opposition No. 91213587

**OPPOSER’S SUPPLEMENTAL BRIEF**

Although the parties have briefed many of the issues involved in this proceeding through motion practice, the parties have yet to address one of Opposer’s grounds for opposition and have not fully addressed the record evidence. Further, since the briefing on Applicant’s summary judgment motion, the Federal Circuit issued a decision clarifying the standard for whether a term is generic and, thus, unable to be registered on the Principal or Supplemental registers. Finally, Applicant’s reply brief raised additional legal arguments that require addressing. Pursuant to the parties’ stipulation, Opposer Frito-Lay North America, Inc. submits this supplemental brief to address these issues.

**I. “Corn thins” and “rice thins” remain generic**

**a. The clarification of the genericness standard does not alter the outcome in this case**

The standard for determining whether a designation is generic in proceedings before the Board has been aptly summarized by the Federal Circuit in the case *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs*:

First, what is the genus of goods or services at issue? Second, is the term sought to be registered or retained on the register understood by the relevant public primarily to refer to that genus of goods or services?

782 F.2d 987, 228 USPQ 528, 530 (Fed. Cir. 1986). In addition to evidence that the terms “corn thins” and “rice thins” are used generically by the public, Opposer has relied in this proceeding upon evidence that the terms are generic compounds, i.e. terms consisting of two generic words that, when combined, provided no additional meaning apart from the meaning of the generic terms. *See generally In re Am. Fertility Soc’y*, 188 F.3d 1341, 51 USPQ2d 1832, 1836 (Fed. Cir. 1999) (holding that “if the compound word would plainly have no different meaning from its constituent words, and dictionaries, or other evidentiary sources, establish the meaning of those words to be generic, then the compound word too has been proved generic” and that “[n]o additional proof of the genericness of the compound word is required”) (citing *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1111-12 (Fed. Cir. 1987)).

A recent decision from the Federal Circuit took the opportunity to emphasize the continuity of the *Marvin Ginn* standard, even when the record contains evidence that the term in question is a generic compound term. The case *Princeton Vanguard, LLC v. Frito-Lay North America, Inc.* concerned the designation “pretzel crisps” for pretzel crackers. 786 F.3d 960, 114 USPQ2d 1827, 1829 (Fed. Cir. 2015). Although the Board considered compound term evidence along with other evidence of the meaning of the designation as a whole (such as consumer surveys and media references) in finding the designation “pretzel crisps” generic, the Federal Circuit expressed concern about how the Board interpreted the relevant standard:

The Board appears to believe that there is a dichotomy in the standard applicable to a particular mark depending on whether it is a compound term or a phrase. According to the Board, if the mark is a compound term, then *Gould* applies, and it can focus on the individual words, but if it is a phrase, *American Fertility* requires that the Board consider the mark in its entirety.

114 USPQ2d at 1830. The court emphasized that the sole standard for determining whether a designation is generic was the two-part test articulated in *Marvin Ginn*, i.e., whether the relevant public understands the mark as a whole to refer to the genus of the goods. *Id.* at 1830-31. Evidence that the mark is a generic compound term is still competent evidence in showing the meaning of the term as a whole, but it would be improper to ignore any additional evidence showing the meaning of the combined term, treating compound term evidence as a shortcut around the general test. *See id.* at 1833. Instead, compound term evidence serves as one kind of relevant evidence that should be considered in tandem with other probative evidence of the use of the term as a whole, such as publications where the alleged mark appears generically, public usage of the alleged mark, and consumer surveys evaluating the perception of the alleged mark. *See id.*

The parties here have not urged the Board to treat the *Marvin Ginn* genericness standard dichotomously, one that applies only if the designation is not a compound term while another special standard applies if the designation is a compound term. On the contrary, Opposer's summary judgment briefing used the compound term evidence in tandem with the evidence of usages of the terms "corn thins" and "rice thins" as a whole to show that the terms are generic and that summary adjudication for Applicant was unwarranted. Opposer's Sum. J. Br. 15-19.<sup>1</sup> Thus, the clarification of the applicable standard, while helpful, does not substantially impact the case at bar. The Board should continue to consider compound term evidence along with evidence showing the usage of the terms as a whole and any probative survey evidence in determining the meaning of the terms as a whole. Based on that evidence, and as discussed in prior briefing, "corn thins" and "rice thins" are generic for Applicant's goods.

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<sup>1</sup> Pursuant to the parties' stipulation and the instructions from the interlocutory attorney, Opposer will not reiterate its prior briefing here.

**b. Applicant is trying to have its “cakes” and eat them too regarding the genus of its products**

In response to the evidence showing wide use of “thins” as a generic term in the contexts of crackers, Applicant argued that such evidence was irrelevant because the genus of the goods is not crackers but “crispbreads, *namely popped corn cakes and rice cakes.*” Applicant’s Sum. J. Reply Br. 5-6. Besides prematurely presuming that its motion to amend will be granted by the Board,<sup>2</sup> Applicant’s argument presents two conflicting ideas: its products are not crackers and, yet, that “popped corn cakes” and “rice cakes” are a kind of crispbread.

The record shows that the dictionary definition of “crispbread” is a cracker. *See* Office Action 33, May 2, 2012, Serial No. 79111074; Office Action 4, 10, Nov. 20, 2012, Serial No. 79111074. In other words, crispbread is a subset of crackers. Applicant has not presented any evidence to the contrary concerning the meaning of “crispbread.” Pels’ attempt to distinguish Applicant’s products from what he believes crackers are does not demonstrate that “crispbread” is not a cracker. Instead, it may demonstrate that “popped corn cakes” and “rice cakes” are not what Pels believes are crackers, but that would be absurd, as that would make Applicant’s products no longer crispbread. Applicant’s attempt cannot be taken seriously considering its position on the issues in the case. If Applicant’s “popped corn cakes” and “rice cakes” are not crackers, then they cannot be crispbread, meaning that the motion to tack on “namely popped corn cakes” and “namely rice cakes” to the applications’ identifications would necessarily fail for broadening the goods beyond the scope of the original identification: crispbread slices. It would also mean that applications are void *ab initio* for lack of actual use or intent to use the designations “corn thins” and “rice thins” for crispbread slices.

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<sup>2</sup> The reasons against granting the motion to amend are outlined in Opposer’s response to Applicant’s motion.

For these reasons, Opposer's evidence concerning the meaning of "thins" in the context of crackers is highly relevant because that is what the identification means, both through dictionary definitions and because Applicant markets its crispbreads as crackers or cracker substitutes. *See Magic Wand, Inc. v. RDB, Inc.*, 940 F.2d 638, 19 USPQ2d 1551, 1552 (Fed. Cir. 1991) (noting that "a proper genericness inquiry focuses on the description of services"); *In re ActiveVideo Networks, Inc.*, 111 USPQ2d 1581, 1600 (TTAB 2014) (noting that the applicant's marketing materials and dictionaries are relevant for determining the genus of goods in the identification).

**c. Applicant's Internet search evidence is inherently skewed and not the best evidence**

One matter not fully discussed on summary judgment was the impact of Applicant's Internet searches, wherein it claims that its "corn thins" products dominate Internet search results. Applicant's Br. 9. In evaluating this evidence for its effect on the question of whether the terms are generic or have acquired secondary meaning, the Board should take the same approach as it did in *In re Greenliant Systems*, 97 USPQ2d 1078 (TTAB 2010). In response to the media references and publications provided by the examining attorney showing that NANDRIVE was used generically, the applicant in that case also submitted media evidence in the form of an Internet search purportedly showing that, in 48 of 52 search results, the term NANDRIVE referred to the applicant. *Id.* at 1083-84. The applicant argued that these results strongly supported its contention that the public considered NANDRIVE to be a trademark, but the Board disagreed. Given that the applicant was the alleged principal user of the compound term NANDRIVE, "its internet and Lexis/Nexis hits are going to be heavily skewed to articles referencing applicant." *Id.* at 1084. Accordingly, the Board did not find this to be a persuasive source of evidence to rebut the other evidence in the record demonstrating that NANDRIVE was

generic. *See id.* It additionally found that NANDRIVE had not acquired distinctiveness on this record. *See id.* at 1084-85 & n.18.

Here, given that Applicant claims to be the substantially exclusive user of “corn thins” in the marketplace, the search for “corn thins” is going to be strongly skewed in its favor such that sheer number of search hits is not going to be an accurate indicator of consumer perception or distinctiveness. Instead, what is more probative of consumer perception is the fact that the designation is being used prominently as a category among its own consumers, as shown by consumer comments, and in the industry. Additionally more probative than the Internet search results is Applicant’s own prominent use of “1 Corn Thin,” “1 Rice Thin,” and “Corn and Rice Thins” in advertisements concerning serving size and nutrition information along with consumer communications indicating that these were not marks but were the generic names of Applicant’s product. Further, if an Internet search were actually good evidence in this case, it is telling that Applicant did not provide an Internet search for “rice thins” given the prominent use of that term by another major cracker producer. Accordingly, the Board should note the substantial deficiencies that Applicant’s Internet search evidence presents and, instead, consider the remaining documentary evidence in the record for determining consumer perception.

**d. Applicant’s reply evidence does not help its case**

In its reply on its summary judgment motion, Applicant submitted additional evidence in an erroneous attempt to rebut Opposer’s evidence that THINS is generic for crackers or crispbreads.

First, Applicant submitted 27 registrations containing “thin” or “thins” without disclaimer, claiming that they rebut the registrations that Opposer submitted with disclaimers. *See Applicant’s Sum. J. Reply Br. App. 45-72.* The vast majority of these are defective. Some

are irrelevant as they involve genera unrelated to crackers or crispbread (COFFEE THINS for “candy” and PINEAPPLE THINS for “processed pineapple”). Several other registrations (the two BARKTHINS registrations and the NUT-THINS, PROTI-THIN, and WATERTHINS registrations) consist of two or more distinct words or abbreviations represented as one word, “(e.g., BOOKCHOICE, PROSHOT, MAXIMACHINE, and PULSAIR).” TMEP § 1213.05(a) (2015). Relying on the absence of a disclaimer for these registrations would be erroneous because such a form does not require a disclaimer of the unregistrable component. *Id.*; *accord In re EBS Data Processing, Inc.*, 212 USPQ 964, 966 (TTAB 1981); *see also* TMEP § 1215.05(a)(ii) (noting that hyphenated constructions also do not require disclaimer of unregistrable component). The same treatment should be given to the two PBTHINS registrations and the two QTHINS registrations, which combine an abbreviation and “thins” represented as one word. The absence of a disclaimer for “thin” or “thins” in these combination registrations proves nothing. Finally, Applicant included nine registrations issued before 2000, not very helpful for the way the word THINS is commonly understood by consumers today. After eliminating these problematic registrations, only a handful lack a disclaimer. When viewed in conjunction with the registrations with a disclaimer and the many office actions in which a disclaimer was required or when a refusal was issued by the PTO, Applicant’s submissions do not change the result that the term “thins” is considered a generic term for the relevant goods.

Applicant also submitted three Internet printouts supposedly rebutting a portion of the Internet printouts showing third-party use of “corn thins,” “rice thins,” or “thins.” *See* Applicant’s Sum. J. Reply Br. App. 28-43. These pages on their face do not prove what Applicant says they prove. The Rude Health webpage contains no statement whatsoever concerning Applicant’s allegations of the geographical availability of Rude Health’s corn thins



and rice thins, leaving Applicant's allegations bald. Concerning the fact that a post on **best-crackers.com** characterized Applicant's "corn thins" as a "corn cracker," if the foreign address of the registrant of the domain name were dispositive concerning whether the post reflects the views of foreign or domestic consumers, then surely all of the visits to Applicant's website and advertisements posted there are disqualified from consideration on the same grounds, as Applicant's address is also foreign. Finally, the Pureharvest page shows that its corn cake thins and rice cake thins "are available in all good health food stores and leading supermarkets throughout Australia," meaning that, even in the country where this product originated, "thins" has no trademark significance.

Applicant's attempt to rebut the documentary evidence is wanting; the fact remains that the documentary evidence shows "thins" used generically for crackers and cracker-like products, and third parties using "corn thins" and "rice thins" for products in the same category as Applicant.

**e. TEFLON surveys have limited probative value in the context of common terms**

Finally, relying on the proffered TEFLON survey over the other documentary evidence of the meaning of the terms would be improper in this case. The original TEFLON survey was employed in a case involving the alleged genericide of an originally fanciful term. *E.I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc.*, 393 F. Supp. 502, 185 USPQ 597 (E.D.N.Y. 1975). That is not the situation here. The terms "corn thins" and "rice thins" both consist of two words in common usage prior to Applicant's entry into the U.S. market. A line of persuasive cases from sister circuits have recognized that, due to its original purpose concerning fanciful terms, the TEFLON survey format has limited probative value in the context of common terms already in use.

The Seventh Circuit recognized this principle in a pair of decisions involving the Miller Brewing Company's attempt to assert trademark rights in the term LITE for low calorie beer. In the first attempt, Miller proffered at a preliminary injunction hearing a consumer survey in which "a substantial percentage of beer drinkers perceived Lite (43%), Miller Lite (11%), or Lite from or by Miller (1%) as a distinct brand name indicative of a low-calorie or less-filling beer." *Miller Brewing Co. v. G. Heileman Brewing Co.*, 561 F.2d 75, 195 USPQ 281, 283 (7th Cir. 1977). The court nevertheless reversed the grant of the preliminary injunction, holding that LITE was a generic term for the goods based primarily on the documentary evidence of record rather than the survey. *See* 195 USPQ at 285-86 (analyzing industry use and dictionary definitions involving LITE and LIGHT).

The Seventh Circuit's determination that LITE was generic was also held against Miller in a concurrently filed action, with the trial court granting summary judgment due to estoppel. *Miller Brewing Co. v. Jos. Schlitz Brewing Co.*, 605 F.2d 990, 203 USPQ 642, 644 (7th Cir. 1979). Arguing that estoppel should not have applied, Miller pointed to an additional survey of 988 beer drinkers purportedly showing that LITE was recognized as a trademark. 203 USPQ at 647. The Seventh Circuit found the survey of limited relevance. The survey's only possible relevance was "to prove the meaning of the word 'light' or to prove that consumers have come to associate the word with Miller's product," *id.*, but proving the meaning of 'light' by a survey was wrongheaded:

When Judge Learned Hand said that whether a word is generic depends on what 'buyers understand by the word,' he was referring to a coined word for a commercial product that was alleged to have become generic through common usage. He was not suggesting that the meaning of a familiar, basic word in the English vocabulary can depend on associations the word brings to consumers as a result of advertising.

*Id.* (citations omitted) (quoting *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921)). Further, proof that the word was associated with Miller’s product would not help the claim either because a generic word cannot become a trademark. *Id.*

Other circuit courts have recognized this principle. The Fourth Circuit considered this issue in *Hunt Masters, Inc. v. Landry’s Seafood Restaurant Inc.*, 240 F.3d 251, 57 USPQ2d 1884 (4th Cir. 2001). Hunt attempted to enjoin Landry’s use of THE CRAB HOUSE based on its prior use of the term CRAB HOUSE in the Charleston geographical area. 57 USPQ2d at 1884-85. To prove that CRAB HOUSE was not a generic term, Hunt provided a survey of consumers in Charleston, but the Fourth Circuit rejected the relevance of the survey evidence. *Id.* at 1886. Recognizing that there are two ways in which a term could be classified as generic—either (1) a coined term that suffered genericide or (2) a term that was generic prior to its association with the products at issue—the court noted that CRAB HOUSE was not a coined term meaning “it is not necessary to determine whether the term has become generic through common use.” *Id.* The Eighth Circuit has also followed the Fourth and the Seventh Circuits on this principle. When Schwan—the owner of such brands of frozen pizza as RED BARON and TONY’S—attempted to enjoin Kraft’s use of BRICK OVEN for its frozen pizza, the trial court entered summary judgment that BRICK OVEN was generic for pizza. *Schwann’s IP LLC v. Kraft Pizza Co.*, 460 F.3d 971, 79 USPQ2d 1790, 1791-92 (8th Cir. 2006). Schwann complained on appeal that the trial court improperly excluded its consumer survey, but the court disagreed, noting that there was no dispute that BRICK OVEN was used before either party had begun using it on their pizza products. 79 USPQ2d at 1794. Citing *Miller Brewing* and *Hunt Masters*, the court held that the survey was not relevant in the context of a purported mark that was not a coined term. *Id.*

These holdings are not surprising given the context of the original TEFLON survey: genericide. The TEFLON survey was employed to see whether a coined term had, over the course of time, become generic because the primary significance to the public had changed from a brand name to a category name. But here, the terms “corn thins” and “rice thins” are not coined terms, despite the pleas of Applicant’s founder to the contrary; they are terms composed of words in common usage well before Applicant’s entry into the domestic market. Thus, Applicant’s attempt to use a TEFLON survey here forgets the purpose for which the survey was originally created. Instead of relying on a TEFLON survey outside of its intended purpose, a survey that also has notable flaws in its design, the Board should instead rely on the documentary evidence demonstrating that the terms “corn thins” and “rice thins” are primarily perceived by consumers as a category name and not as a brand name.

## **II. Alternatively, “corn thins” and “rice thins” cannot function as trademarks**

Alternatively, the evidence demonstrates that the terms “corn thins” and “rice thins” are so highly descriptive of Applicant’s goods as to be incapable of acquiring distinctiveness as a mark.

### **a. Standard for determining trademark capability**

Generic designations are not the only designations that cannot be registered. The precedent of the Board and the Federal Circuit also prohibit the registration of designations which, while not technically identical in meaning to the genus of the goods involved, are so highly descriptive of those goods that they lack the capacity to become distinctive marks, even if they accrue de facto secondary meaning.

The Boston Beer Company confronted this situation when it attempted to claim trademark rights in the designation “The Best Beer in America.” *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056 (Fed. Cir. 1999). It argued that its admittedly descriptive slogan had

obtained secondary meaning, citing \$85 million in sales, \$10 million in advertising expenditure, and the fact that competitors had recognized that “The Best Beer in America” referred to the applicant’s beer. 53 USPQ2d at 1057. The Board nevertheless refused registration. Although it did not find the slogan generic for the applicant’s goods, it nevertheless held that the slogan could not function as a trademark regardless of the evidence of secondary meaning. *Id.* at 1058. The Federal Circuit agreed. Although the Federal Circuit noted that laudatory slogans were not unregistrable per se, in this case the record showed that the slogan was so highly descriptive of the applicant’s goods that it was not capable of distinguishing applicant’s goods from the goods of others. *Id.* at 1058-59.

The Board has applied the same reasoning when encountering designations that, while not technically generic for an applicant’s goods, are so close in meaning that they are not capable of obtaining trademark significance. The most prominent example is the case *In re Wm. B. Coleman Co.*, 93 USPQ2d 2019 (TTAB 2010). The applicant tried to claim trademark rights in the designation “Electric Candle Company” for use with electric candles, arguing that the designation was descriptive with acquired distinctiveness and that, per *Marvin Ginn*, the public would not understand the designation to refer to the genus of the goods “electric candles.” *Id.* at 2027. The Board nevertheless held that the designation was unregistrable, even if applicant’s contention were true:

As has been found in other cases, marks may not equate to the literal name of the goods or services for which registration is sought, but still be deemed to be ‘generic’ ***or otherwise incapable of attaining source significance*** and thus unregistrable, even on the Supplemental register.

*Id.* (emphasis added) (citing *In re Boston Beer Co.*, 198 F.3d 1370, 53 USPQ2d 1056). Thus, even though “electric candle company” and “the best beer in America” were not the generic

name for the goods under *Marvin Ginn*, they were nevertheless found incapable of serving as trademarks as they were so highly descriptive of the goods sought to be registered.

**b. The evidence shows that Applicant’s “marks” cannot function as source identifiers**

Here, the Board should find that, at a minimum, the designations “corn thins” and “rice thins” are so close in meaning to the genus of Applicant’s goods that they cannot function as trademarks capable of attaining source significance. The evidence shows that “corn” and “rice” lack trademark significance in the context of Applicant’s goods, both due to Applicant’s disclaimer of the terms and due to industry usage for corn-based snack foods and rice-based snack foods. Further, the evidence shows that the word “thins” is widely used by the industry and consumers as a name for crackers and crispbreads. The terms when combined convey an immediate, direct, and unmistakable idea of the basic features, ingredients, characteristics, attributes, or qualities of the genus of the identified goods; that is, Applicant’s products are necessarily thin crispbreads made of corn and rice. Further confirming the inability to function as a trademark is the fact that third parties use the designation and the low recognition received in market research despite Applicant’s claim of use since 2004.

Thus, because of at least how close in meaning these terms are to their generic categories, “corn thins” and “rice thins” cannot function to identify and distinguish Applicant’s goods from other corn-based or rice-based thins of others and should remain available for all competitors to use. The Board should accordingly refuse registration of these terms.

**III. Errata**

Opposer notes the following locations in its brief in response to Applicant’s Motion for Summary Judgment that contained an incomplete citation to the record. Although Opposer fully

summarized and discussed this evidence earlier in its summary judgment brief at Part III.C.iv, it submits following correction for the sake of completeness:

Location	Revised text
Page 18, line 21	subject of disclaimer requirements and/or descriptiveness rejections. <del>Rausa Decl. App. 361-62, 393-95, 526-27, 647-49, 777-79, 800-02, 920, 923-25, 988, 994-97, 1088-89, 1136-37, 1175-76, 1234, 1240, 1242-43, 1276-81, 1335-37, 1364-69, 1398 1402-04, 1471-75, 1490-91, 1535-37, 1568-70, 1628-29, 1643-44.</del>

#### IV. Conclusion

The probative evidence bearing on the meaning of the terms “corn thins” and “rice thins” as a whole show that the terms have the same or substantially similar meaning as the genus of goods for which Applicant seeks registration. The Board should therefore refuse registration.

Respectfully submitted,

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**CERTIFICATE OF SERVICE**

I certify that today, December 1, 2015, I served a copy of the foregoing OPPOSER'S SUPPLEMENTAL BRIEF by sending it via First Class Mail, postage prepaid, to counsel for Applicant at the address below:

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